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Application No. FJ-2000-009-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re patent application of

Koji NAKAMURA, et al.

Serial No.: 09/624,916

Group Art Unit: 2624

Filed: July 24, 2000

Examiner: Tran, Douglas Q.

For: APPARATUS AND METHOD FOR DESIGNING COMMUNICATION
PATHS OF TREE STRUCTURE

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

**SECOND PETITION FOR NEW OFFICE ACTION UNDER 37 C.F.R. 1.181 AND
WITHDRAWAL OF HOLDING OF ABANDONMENT**

Sir:

In response to the abandonment of the above-identified application, and in accordance with Delgar, Inc., v. Schuyler (172 USPQ 513) (DDC 1971) and MPEP § 711.03(c), page 700-92, second column (Ed. 7, July 1998), Applicants hereby petition for a new Office Action and for withdrawal of the holding of abandonment.

Applicants point out that a Petition for New Office Action was filed on December 3, 2004, and Applicants have not yet received a response from the Patent Office.

After a routine file review due to inactivity of this matter, a Status Inquiry and a Change of Address were filed in the Patent Office on November 16, 2004 (Exhibit 1).

A follow-up status search on our newly activated access to the private PAIR system performed on November 23, 2004, indicated that a Notice of Abandonment was allegedly mailed on October 19, 2004, and that the file was abandoned "for Failure to Respond to Office Action." The File History on the PAIR system (Exhibit 2) indicates that a Non-Final Rejection was mailed on January 5, 2004. The File History also reflects a Correspondence Address Change on September 18, 2000 and September 25, 2000. However, Applicants have not received any communication from the U.S. Patent and Trademark Office (PTO) since receipt of the Recordation of Assignment on January 12, 2001.

Accompanying this Petition is the Declaration of Mary C. Gibb, Manager of the Docketing Department in the undersigned's law firm. As set forth in that Declaration, Ms. Gibb, in her capacity as Manager of the Docketing Department, is intimately familiar with all of the details regarding the processing of mail received in the Docketing Department, including correspondence received from the PTO. Attached to the Declaration is supporting documentation (Exhibits A and B) showing that no Office Action in the subject application was processed by the Docketing Department or received by the undersigned's law firm.

Further, attached as Exhibit C to the Declaration of Ms. Gibb is a copy of the front cover of the subject application file jacket maintained by the undersigned's law firm. It should be noted that the file jacket cover shows the chronological sequence of correspondence between the undersigned's law firm and the PTO. As noted on the cover, the application was filed on July 24, 2000, with Declaration. There is no indication of receipt of any Office Action by the undersigned's law firm.

Exhibits A and B are copies of the docket record showing all actions due by the firm of McGinn & Gibb, PLLC, at and around the alleged due date of April 20, 2004, and Exhibit C is the file jacket cover. This evidence is acceptable proof of non-receipt as provided by 1156 O.G. 53.

It is noted that change of address forms for our customer number were filed on October 24, 2000, October 31, 2000, November 13, 2001, and March 27, 2002, copies of which are attached hereto as Exhibits 3-6, as well as copies of two follow-up acknowledgments received from the PTO, dated October 25, 2000, and November 16, 2001, respectively (Exhibits 7 and 8).

Further, a 89-page Correspondence Address Indication Form listing applications being handled by this firm and linking our Customer No. 21254 with our current address (8321 Old Courthouse Road, Suite 200, Vienna, VA 22182-3817) was filed in the PTO on December 4, 2003. A copy of the page of said Form which included the above-identified application and a copy of the stamped postcard filing receipt are attached as Exhibit 9.

It is also noted that numerous Change of Address Orders have been filed with the U.S. Postal Service. The most recent Change of Address Order prepared on October 8, 2003 (Exhibit 10), was effective until November 2004, and receipt thereof was confirmed by the Postal Service.

The undersigned has been associated with McGinn & Gibb, PLLC (now McGinn Intellectual Property Law Group, PLLC), for a number of years, and in that time has been able to rely on the performance of the Docketing Department to provide conscientious, reliable, and competent notice of due dates for responses to correspondence received from the PTO. Based on the undersigned's familiarity with the good work performed by the employees of the

Docketing Department, it is respectfully submitted that the only reasonable conclusion is that no Office Action was ever received by the undersigned's law firm for the above-identified application.

Further, in accordance with MPEP § 707.13, if the Office Action was mailed to our former address and returned to the PTO, the Examiner should have used "every reasonable means to ascertain the correct address and forward the action again." The Examiner could have quickly ascertained the correct address in a number of ways including, but not limited to, the associated customer number and the undersigned's registration number. In addition, the inventors and/or assignee were not informed of the returned action.

Pursuant to the above-noted association with Customer No. 21254, numerous changes of address for the customer number, numerous changes of address with the Postal Service, and detailed description of docket record provided in the Declaration of Ms. Gibb and copy of file jacket cover, which are believed to satisfy fully the requirements set forth in MPEP § 711.03(c) and 1156 O.G. 53, and the lack of adherence to MPEP § 707.13, Applicants respectfully request that a new Office Action be sent in the subject application and that the holding of abandonment be withdrawn.


Applicants submit that the Declaration of Mary Gibb, as well as Exhibits A and B, were previously submitted with Applicants' Petition filed on December 3, 2004. For the convenience of the Patent Office, Applicants have attached copies of the Declaration and Exhibits 1-10 and A-C.

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Since this error is due to the U.S. Patent and Trademark Office, no fee is believed necessary. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-0481.

Respectfully submitted,


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Registration No. 48,317
Sean M. McGinn
Registration No. 34,386

Date:

August 14, 2006

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mm/r1 MA5802

Attorney's Post Card Filing Receipt
Serial Number: 09 1024, 9/4

Papers Filed On: 12/03/04



Attorney's Docket Number: FJ-2000-0094 ☒ Patent ☐ Trademark

Applicant's Name: Nakamura et al Application Filing Date: 07/24/00
Items Filed Herewith:

- ☒ Amendment ☐ Request for Extension of Time ☐ CPA Request
- ☒ Notice of Appeal ☐ Appeal Brief (in triplicate) ☐ Reply Brief
- ☒ IDS DEC 03 2004 ☐ 1449 Form w/ 1 Documents ☐ Priority Document(s)
- ☒ Declaration by C. Gbb ☐ Recordation Cover Sheet ☐ Formal Drawings
- ☒ Assignment 1-2 ☐ Drawing Corrections ☐ Issue Fee Transmittal ☐ Missing Parts

Other Petition for New Office Action w/drawal of Abandonment

Filed Herewith: \$ ☐ Check ☐ Charge Deposit Account: (w/ exhibits)

Hand Delivered

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